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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/574,413	09/17/2007	Gilles Lorentz	R-03131.US	9704

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EXAMINER	
PENG, KUO LIANG	
ART UNIT	PAPER NUMBER
1796	
MAIL DATE	DELIVERY MODE
03/30/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/574,413	LORENTZ ET AL.	
	Examiner	Art Unit	
	Kuo-Liang Peng	1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *3/31/06 Prel. Amendment*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13 and 16-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13, 16-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *3/31/06*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. The Applicants' preliminary amendment filed March 31, 2006 is acknowledged. Claims 14-15 are deleted. Claims 1-13 are amended. Claims 16-18 are added. Now, Claims 1-13 and 16-18 are pending.

Specification

2. The disclosure is objected to because of the following informalities:

Applicants are reminded that a brief description of the drawing is missing.

Appropriate correction is required.

Double Patenting Rejection

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either

anticipated by, or would have been obvious over, the reference claim(s). *See, e.g., In re Berg, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 8 and 13 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable

over Claims 42-47 of copending Application No. 10/575,144. Although the conflicting claims are not identical, they are not patentably distinct from each other because Claims 42-47 of the copending Applications are directed to a product obtained by a coating process that obviously reads on that in the presently claimed invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 2 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claim 2 (line 4), the phrase “x = 9.5, y = 3.5, e = 11.5 and p = 2.5” causes confusion because “x”, “y”, “e” and “p” can only be whole numbers.

Claim 18 contains the trademark/trade name "Versatate". Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a vinyl ester and, accordingly, the identification/description is indefinite.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 1, 3-13 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yanutola (US 2005 0014886) as evidenced by Walele (US 6 552 212) and SilwetSurfactant (Silwet Surfactants -- Momentive Performance Material, 2008).

For Claims 1, 3-5, 13 and 16-18, Yanutola discloses a composition for coating a substrate, which comprises an aqueous dispersion of a film-forming polymer such as acrylic polymer, etc. and a sufficient amount of a silicone polyether ([0001], [0015]-[0016], [0030]-[0033] and [0050]-[0061]) The value ranges of x, y, u and v fully encompass those somewhat narrower ranges of x, y, e and p in the presently claimed formula (I), respectively. Thus, a *prima facie* case of obviousness exists. Yanutola further teaches that the silicone polyether can have a primary structure as taught in Walele. ([0051]) Thus, Walele teaches silicone polyethers derived from SILWET L-7604, etc. (col. 6, lines 30-40) In view of SilwetSurfactant's disclosure on the relative amounts of the oxyethylene units and oxypropylene units and the molecular weight of the SILWET L-7604 (page 24), the claimed limitations of "e/p" and "x+y" are met. Yanutola is silent on the ratio of the number of the dialkylsiloxane units to that of the

polyoxyalkylene-containing siloxane units (i.e., “x/y”) and the length of polyoxyethylene in SILWET L-7604 (i.e., “e+p”). However, the values of “x/y” and “e+p” would affect the release properties of the composition. In other words, these values are Result-Effective variables. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize a silicone polyether having whatever "x/y" and "e+p" values through routine experimentation in order to afford a composition with proper release property. Especially, Applicants do not show the criticality of these values. See MPEP 2144.05 (II). Notably, SilwetSurfactant is cited here merely to show the identity of SILWET L-7640. For Claims 6-7, Yanutola is silent on the amount of the silicone polyether. However, the amount of the silicone polyether can affect release property of the composition. ([0060]-[0061]) In other words, the amount is a Result-Effective variable. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize a silicone polyether in whatever amount through routine experimentation in order to afford a composition with proper release property. Especially, Applicants do not show the criticality of the amount. See MPEP 2144.05 (II). For Claims 8-12, since Yanutola's coating composition is substantially

the same as the presently claimed one, Yanutola's coating process would impart the same effect on the surface of hydrophobic substrates such as ***polypropylene***, etc. ([0094]).

9. Claim 2 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Seidleck, can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private

PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

klp
March 24, 2010

/Kuo-Liang Peng/
Primary Examiner, Art Unit 1796